

Notice of Allowability

Application No.

09/740,420

Examiner

C. Michelle Colon

Applicant(s)

HARSHAW, BOB F.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed 6/15/04.
2. ☒ The allowed claim(s) is/are 1-10 and 12-17.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

EXAMINER'S AMENDMENT

1. The following is an Allowance in response to the communication received on June 15, 2004. Claim 11 has been cancelled. Claims 1-10 and 12-17 are now pending in this application.

Terminal Disclaimer

2. The terminal disclaimer filed on September 14, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Pat. No. 6,542,871 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Dale Ream on September 16, 2004. The application has been amended as follows:

In the claims:

9. An automated method for developing new products, comprising:

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providing a plurality of pools, each pool associated with a predetermined subject matter and administered by a pool manager;

electronically receiving a predetermined number of new product concepts into each said pool, each said new product concept being registered by a submitter to one of said pools having a subject matter in common with the subject matter of said new product concept;

formulating a market survey relative to each new product concept;

submitting each market survey to each of said plurality of submitters and soliciting a response relative thereto;

analyzing said responses to said market surveys whereby to select said one new product concept for market introduction;

transforming each said selected new product concept into a developed new product suitable for introduction to the marketplace;

introducing each said selected new product concept into the marketplace whereby to obtain sales transactions therefore; and

wherein [said] distribution parameters include making payment of a first royalty to the submitter of said selected new product concept and making payment of a second royalty smaller than said first royalty in equal amounts to the submitters of each new product concept not selected and making payment of a third royalty smaller than said first royalty payable to said pool manager.

Reasons for Allowance

4. Claims 1-10 and 12-17 are allowed.
5. The following is an examiner's statement of reasons for allowance: None of the prior art of record, taken individually or in any combination, teach, *inter alia*, receiving a plurality of new product concepts from a plurality of submitters; selecting a new product concept for market introduction; transforming the selecting new product concept into a developed new product suitable for introduction to the marketplace; licensing or distribution parameters including making payment of a first royalty to the submitter of a selected new product concept and ***making payment of a second royalty smaller than the first royalty*** to the submitters of each new product concept ***not selected*** and ***making payment of a third royalty also smaller than the first royalty payable to the manager of the product concepts***. Examiner notes that the reasons for allowance reflect the same reasons for allowance applied in the parent application, now U.S. Pat. No. 6,542,871. Additionally, Examiner notes the allowed claims are within the technological arts as required by 35 U.S.C. 101 because of the limitation in at least the independent claims that discusses transforming the selected new product concept into a developed new product suitable for introduction to the marketplace.

The prior art references most closely resembling the Applicant's claimed invention are Asplen, Jr (U.S. 6,044,354), Kossovsky et al. (U.S. 2002/0004775) and incubate.com.

First, Asplen, Jr. discloses a product planning system that includes submission of product ideas and further analyzing the submitted ideas for technical, market and strategic feasibility, wherein an idea deemed qualified may be selected for further development. However, Asplen, Jr. does not teach or suggest receiving a plurality of new product concepts from a plurality of submitters; selecting a new product concept for market introduction; transforming the selecting new product concept into a developed new product suitable for introduction to the marketplace; licensing or distribution parameters including making payment of a first royalty to the submitter of a selected new product concept and making payment of a second royalty smaller than the first royalty to the submitters of each new product concept not selected and making payment of a third royalty also smaller than the first royalty payable to the manager of the product concepts.

Second, Kossovsky et al. discloses an online patent and license exchange for marketing patents for potential licensing agreements with interested parties. The seller of a patent can dictate the royalty rate, which is the percentage of the licensee's or buyer's sales of the product that will be paid to the seller. However, Kossovsky et al. does not teach or suggest receiving a plurality of new product concepts from a plurality of submitters; selecting a new product concept for market introduction; transforming the selecting new product concept into a developed new product suitable for introduction to the marketplace; licensing or distribution parameters including making payment of a first royalty to the submitter of a selected new product concept and making payment of a second royalty smaller than the first royalty to the submitters of each new product

concept not selected and making payment of a third royalty also smaller than the first royalty payable to the manager of the product concepts.

Third, incubate.com discloses a website through which submitters could submit their new product concepts for development into marketable products. Submitters pay a registration fee in order to submit their new product concept. The registration fee is then used to develop and market the selected product concepts. However, incubate.com does not teach or suggest receiving a plurality of new product concepts from a plurality of submitters; selecting a new product concept for market introduction; transforming the selecting new product concept into a developed new product suitable for introduction to the marketplace; licensing or distribution parameters including making payment of a first royalty to the submitter of a selected new product concept and making payment of a second royalty smaller than the first royalty to the submitters of each new product concept not selected and making payment of a third royalty also smaller than the first royalty payable to the manager of the product concepts.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Turnbull (EP 467584 A2) discusses a method and structure for monitoring product development;
- Eisman, Regina. "Remaking a Corporate Giant." *Incentive*, v166, May 1992, p 57(5), discusses IBM's incentive packages for employees including its Invention Achievement Award, which gives cash and certificates for outstanding patent applications;
- DiEdoardo, Chris. "Professors' royalties protected by court." *San Diego Daily Transcript*, October 6, 1997, discusses royalty payment structures made to professors for their patented discoveries;
- GE – Submitted Ideas Program [online], [retrieved on 2002-06-13]. Retrieved from the Internet: <URL: <http://www.ge.com/subideas.htm>>, discusses GE's idea submission process including compensations awarded;
- Meehan, Robert H. "Programs that Foster Creativity." *Personnel*, v63, February 1986
- DeSouza, Glenn. "Royalty methods for intellectual property." *Business Economics*, v32, n2, p46(7), April 1997, discusses determining royalty rates for firms that license intellectual property;

- Garage Technology Ventures [online], [retrieved on 2002-01-10]. Retrieved from the Internet: <URL: <http://www.garage.com>>, is an incubator that develops, funds, and brings new product concepts to market;
- Think Tank [online], [retrieved on 2002-01-10]. Retrieved from the Internet: <URL: <http://www.thinktank.com>>, is a company that develops, funds, and brings new product concepts to market;
- Katalyst [online], [retrieved on 2002-01-10]. Retrieved from the Internet: <URL: <http://www.katalyst.com>>, is a venture firm that helps grow sustainable businesses;
- Aurora Funds [online], [retrieved on 2002-01-10]. Retrieved from the Internet: <URL: <http://www.aurorafunds.com>>, is a venture capital firm that provides resources to help entrepreneurs develop their ideas into businesses;
- Whiddon, Robert L. "Venture-backed IPO: Garage.com Swings Open IPO Door," Private Equity Week, February 21, 2000, discusses the business of Garage.com and the venture capital industry;
- iventurelab [online], [retrieved on 2002-01-10]. Retrieved from the Internet: <URL: <http://www.iventurelab.com>>, discusses a venture capital firm;
- Hayes, Susan. "The source 1993," Success, vol. 40 no. 6, August 1993, pp. 37 – 40, discusses the resources available to entrepreneurs seeking capital for their ideas;

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- Carlson, Steven. "Patent pools and the antitrust dilemma," *Yale Journal on Regulation* v16n2, Summer 1999, [retrieved from Dialog], discusses royalty structures within a patent pool;
- Niemann, Paul. "The Online Inventor," May 1999 [retrieved from Internet], discusses royalty payments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306

[Official Communications; including After Final
communications labeled "Box AF"]

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703-746-7202

[For status inquiries, draft communication, labeled

"Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA 7th floor receptionist.


cmc

September 15, 2004


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